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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,273	12/29/2000	George W. Rozakis	1683-G	9130

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EXAMINER

RAMANA, ANURADHA

ART UNIT

PAPER NUMBER

3751

DATE MAILED: 10/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/752,273

Applicant(s)

ROZAKIS ET AL.

Examiner

Anu Ramana

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 7-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 24-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6 and 24-25 are drawn to a system, classified in class 606, and subclass 10.
- II. Claims 7-23, drawn to a method, classified in class 606, subclass 5.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as a process and apparatus for its practice. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be practiced by another materially different apparatus or by hand; or (2) that the apparatus as claimed can be used to practice another and materially different process (MPEP 806.05(e)). In the instant case the process can be practiced by an apparatus not having the particulars of the claimed invention, for e.g. an ablation means that is not a laser.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their divergent subject matter, restriction for examination purposes as indicated is proper.

A telephone call made to Fred H. Zollinger on 9/12/02 resulted in election of the invention of Group I.

Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention since it is unclear what type of laser is being claimed.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

*Claims 1, 3, 5, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Warner et al.*

Warner et al. disclose an apparatus 20 with a laser source 24, a beam shaping means (26, 27 and 28) and a control means 29 (Figure 2, col. 3, lines 51-52, lines 64-68 and col. 4, lines 8-24) wherein the laser beam is utilized for a first far-vision enhancing curvature profile in an outer annulus or zone D<sub>3</sub>-D<sub>5</sub> (“positive diopter correction”) and a second near-vision enhancing curvature profile (“negative diopter correction”) in an inner central area defined by diameter D<sub>5</sub> of the optically used area of cornea 11 (Figure 1, col. 3, line 5, col. 4, lines 33-55, col. 5, lines 14-16, and col. 7, lines 20-29).

The initial statement of intended use and all other functional implications related thereto have been considered but do not appear to impose any patentably distinguishing structure over that disclosed by Warner et al.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

*Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Warner et al. in view of Ruiz (6,302,877).*

Warner et al. do not disclose the type of laser utilized during keratomileusis. See previous discussion for claim 1.

Ruiz teaches the use of an excimer laser in Laser in situ Keratomileusis (LASIK) treatment for altering the surface of a cornea.

Accordingly it would have been obvious to one of ordinary skill in the art at the time of the invention to have provided an excimer laser as taught by Ruiz in apparatus 20 of Warner et al. to enable the use of apparatus 20 for LASIK treatment.

*Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warner et al.*

Regarding claim 4, Warner et al. disclose that the optically used central area of cornea 11 has a diameter  $D_3$  in a range of 4 to 6 mm (col. 4, lines 24-32) wherein 6 mm represents the maximum diameter of the first zone. See previous discussion for claim 1.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the claimed system in a first zone having a diameter of 6 mm and a second zone having a diameter of 4 mm since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Regarding claim 6, a human eye could require a positive diopter correction equal in magnitude to the negative diopter correction since this is dependent on the structure of the particular cornea. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the claimed system for a providing a positive diopter correction equal in magnitude to the negative diopter correction since this is one selection of numerous possible values dependent on the cornea being treated.

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***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (703) 306-4035. The examiner can normally be reached on 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (703) 308-2580. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0975.

AR

October 1, 2002

  
TIMOTHY L. MAUST  
PRIMARY EXAMINER